

## REMARKS

By this response, Applicants have not amended the claims. As a result, claims 24-47 remain pending in this application. Reconsideration in view of the following remarks is respectfully requested.

In the Final Office Action, the Office provisionally rejects claims 24-47 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 12-33 of the co-pending Application No. 09/709,433. Applicants respectfully reserve the right to traverse this provisional rejection or file a terminal disclaimer at a later time should all other rejections and/or objections be resolved.

Furthermore, the Office rejects claims 24-47 under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for generating and transmitting print files and prompting the user without any further user interaction after the request to print. Applicants traverse these rejections.

Initially, Applicants note that the limitations "prompting the user without any further user interaction after the request to print" cited by the Office (Final Office Action, p. 3, paragraph 2, lines 3-4) are not in any of the claims.

Additionally, with respect to claim 24, Applicants note that several portions of the specification and figures describe generating a print file and automatically transmitting the print file to a server without further user interaction as claimed therein. See, e.g., specification, p. 18 and Fig. 7, 605, 610; and pp. 20-21 and Fig. 9, 506, 532.

Furthermore, the Office cites page 23, lines 9-14 of the specification as allegedly discussing "that a user would have to manually log in to the system between the steps

of generation and transmission." Final Office Action, p. 3. However, Applicants note that the specification includes only 22 pages. Regardless, even if, *arguendo*, entry of user credentials or verification of stored user credentials via a sign in screen comprises user interaction, Applicants note that the user interaction is not initiated by the user. In contrast, the server transmits a sign in screen for authentication, and therefore initiates the interaction. To this extent, Applicants submit that one skilled in the art is readily enabled by the specification to make and use a method of previewing a document in which a print file is generated in response to a print request and automatically transmitted over a network for processing by a server without user-initiated interaction with the server as in claim 24.

Applicants note that the specification includes similar support for the system of claim 32 and the computer program product of claim 36. In light of the above, Applicants respectfully request withdrawal of the objection to claims 24-47 as allegedly not being enabled by the specification.

Further, the Office rejects claims 24-28, 30-39, and 41-47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske) in view of U.S. Patent No. 6,134,568 (Tonkin). Applicants respectfully submit that the Office fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests all of the features of the claimed inventions.

For example, with respect to claim 24, Applicants respectfully submit that the Office fails to show that the proposed combination of Adamske and Tonkin teaches or suggests automatically transmitting a print file for processing by a server over a network

in response to generating the print file without user-initiated interaction with the server as claimed therein.

Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-19. In order to perform the conversion, "the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents." Adamske, col. 5, lines 19-21. The converted printable electronic document is then transmitted to a web server, where it is processed to create web-viewable print preview files. Adamske, col. 5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, "the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server." Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user "sends this metafile to [the application] translation server

through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” Adamske, col. 6, lines 49-52.

Interpreting Tonkin only for the purposes of this response, Tonkin provides a web page in which a user enters a source file that includes the content to be included in a document. Tonkin, FIG. 5B; col. 7, lines 13-17. The source file can be a PDF file or another format, which can be first converted to PDF format. Tonkin, col. 7, line 17-27. Subsequently, image(s) of the document are generated and displayed. Tonkin, col. 12, lines 23-34.

Contrary to both embodiments of Adamske and the teachings of Tonkin, Applicants' claim 24 generates a print file on a client based on a document using a print driver executing on the client in response to a print request for the document designating the print driver, and automatically transmits the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server. To this extent, prior to receiving image data on the client and displaying the image data in an interface to preview a document, a print file is generated on the client in response to a print request and transmitted for processing by a server without user-initiated interaction with the server. In contrast, in the first embodiment of Adamske and Tonkin, the user is required to request that the document be transmitted using a web browser or by sending an email. In the second embodiment of Adamske, the preview is performed before any communications with a server occur and before a printable version of the document is generated. In this manner, the invention of claim 24 integrates use of the server into a method of previewing a document, which does not

require a user to access a website via a web browser or email a document as in Adamske and Tonkin.

In response to Applicants' arguments, the Office states that

Adamske et al teaches automatically user uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (col. 5, lines line 64- thru col. 7, line 15, clearly once the file is received thew (sic) configuration wizard can send it to the server, no user interaction is needed).

Final Office Action, p. 4, lines 8-11. Initially, as best understood by Applicants, the Office apparently alleges that a user uploading a print file to a server is performed automatically ("... teaches automatically user uploading or transmitting..."). Applicants note that any action performed by a user is not automatically performed as alleged by the Office. Further, Applicants note that Adamske does not teach the user uploading a print file. In contrast, the user transmits either an electronic document or a metafile, both of which are later converted to a print file.

Additionally, as best understood by Applicants, the Office apparently alleges that communications between the application translation server and the web server of Adamske are performed without user interaction. However, Applicants note that, contrary to the invention of claim 24, such communications are not performed in response to a print file being generated on a client based on a document using a print driver executing on the client in response to a print request for the document designating the print driver as claimed therein.

In light of the above-stated reasons, Applicants respectfully request withdrawal of the rejections of claim 24 and claims 25-28, 30-31, and 44-47, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

With respect to claim 32, Applicants submit that the Office fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests a system for previewing a document that includes all the features claimed therein. For example, for reasons that should be clear from the discussion of the proposed combination of Adamske and Tonkin above, Applicants submit that the proposed combination of Adamske and Tonkin fails to teach or suggest the system of claim 32, including an upload manager for automatically transmitting a print file over a network for processing by a server in response to the print file being generated without user-initiated interaction with the server. As a result, Applicants request withdrawal of the rejection of claim 32 and claims 33-35, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

With respect to claim 36, Applicants submit that the Office fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests a computer program product that includes all the features claimed therein. For example, for reasons that should be clear from the discussion of the proposed combination of Adamske and Tonkin above, Applicants submit that the proposed combination of Adamske and Tonkin fails to teach or suggest program code for previewing a document that comprises program code for automatically transmitting the print file over a network for processing by a server in response to the generating without user-initiated interaction with the server. As a result, Applicants request withdrawal of the rejection of claim 36 and claims 37-39 and 41-43, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

Further, the Office rejects claims 29 and 40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin and further in view of U.S. Patent Application Publication No. 2001/0043753 (Grohs). With respect to claims 29 and 40, Applicants respectfully submit that the Office fails to show that each and every feature of the claimed invention is taught or suggested by the Office's proposed combination of Adamske in view of Tonkin and further in view of Grohs. Applicants note that the Office relies on its interpretation of Adamske in view of Tonkin as allegedly teaching all the features of claims 24 and 36, from which these claims respectively depend. To this extent, Applicants hereby incorporate the arguments presented above for claims 24 and 36. Further, Applicants note that the combination of Adamske, Tonkin, and Grohs, even if, *arguendo*, proper, fails to address the deficiencies of Adamske and Tonkin cited above with respect to claims 24 and 36. As a result, Applicants request withdrawal of the rejections of claims 29 and 40 as allegedly being unpatentable over the proposed combination of Adamske, Tonkin, and Grohs.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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